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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 37

Application Number: 08/587,448
Filing Date: 01 December 1995
Appellant(s): Tse Ho Keung

Tse Ho Keung
For Appellant

EXAMINER'S ANSWER

MAILED
JUL 20 1998
GROUP 2200

This is in response to appellant's brief on appeal filed 09 July 1998.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-7 and 9-21.

Claims 6, 7, 10, 14, and 20 have not been canceled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No previously submitted amendments after final have been entered.

No amendment after final dated 4 April 1998 has been received.

The amendments to claims 1, 12, and 17 contained in Appendix B were entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Issue D) seems to be concerned with U.S.C. 101. There is no rejection under section 101 in the final office action.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 12, and 17 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

Claims 6, 7, 10, 14, and 20 are missing from the Appendix A to the brief, and are therefore considered as containing substantial errors. Accordingly, claims 6, 7, 10, 14, and 20 are presented in the Appendix to the Examiner's answer.

Note that claims 1, 12, and 17 (the independent claims) appear in their current form in Appendix B to the Appeal Brief (pages 28- 30)

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,548,465

ANANDA

8-1996

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-7 and 9-21 rejected under 35 U.S.C. 102(e) and 112. These rejections set forth in prior Office action, Paper No. 10, are reproduced below.

Claim Rejections - 35 U.S.C. § 112

a. Claims 1-7 and 9-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

After entering the amendments of Appendix B, the claims are still full of grammatical errors and dangling clauses which make the scope of the claims indeterminate.

b. Claims 1-7 and 9-21 are rejected as failing to define the invention in the manner required by 35 U.S.C. § 112, second paragraph.

The claims are replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. Note the format of the claims in the patent cited.

For examination, the claims were understood as software(on a medium) for copy protection of other software.

Claim Rejections - 35 U.S.C. § 102

c. Claims 1-7, and 9-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ananda ('645).

(11) Response to Argument

Issue A (corresponds to rejection 10a):

Applicant argues (Appeal Brief, page 8) that although the claims are indeed full of grammatical errors and dangling clauses this does not make the scope of the claims indeterminate since the claims "read on" specific portions of the specification.

Response: The claims are what are being examined. Even with the changes of Appendix B the claims still do not particularly point out the invention.

Two difficulties in understanding claim 1 as amended in Appendix B are provided below. Claims 12 and 17 suffer from similar textual problems.

Phrase 1 (lines 1-4): This phrase has a computer and authorizing software. It is not clear which is "meeting an existing standard" or whether "without modification thereof" refers to "any software product" or to the "computer".

Lines 5-6:

"said authorising software being for when executed, 1) authorising other software which being protected from unauthorised use, to be used on said computer (A);"

Even after this round of corrections (which makes the claims more readable), the Examiner still can not parse this phrase in a meaningful manner.

Issue B (corresponds to rejection 10b):

Applicant argues that the invention is a "useful material".

Response: The examiner does not see the relevance of this argument to the rejection. The claims are in narrative form, use primarily intended use and functional language without positive recitations.

The following tabulation addresses claim 1 as amended in Appendix B (claims 12 and 17 are similar).

Phrase 1 (lines 1-4):

line 2: "for use on a computer ..." Intended use

Phrase 2 (lines 5-7):

line 5: "being for when executed.." Intended use

Phrase 3 (lines 8-10):

line 10: "for use on ..." Intended use

Phrase 4 (lines 11-16):

line 11: "being for to be authenticated .." Intended use

Phrase 5 (lines 17-20):

line 17: "wherein ..." Intended outcome

No positive recitation

Phrase 6 (lines 21-23):

line 17: "wherein ..." Description of what is not in system

No positive recitation

Issue C (corresponds to rejection 10c): 102(e)

(I) Applicant argues that there is no software in Ananda which can meet the claimed "identity software" (Appeal Brief, page 15).

Response: The only characteristic of the "identity software" determinable from the claim language is that it provide identity information. Ananda has software on the user computer which interacts with the software at the remote center to authorize and bill for the usage. The identity of the user computer is a critical component of Ananda's application to ensure correct monitoring and billing.

(ii) Applicant argues that Ananda deals with rental, while claim 12, line 14 specifies purchase.

Response: Ananda discloses rental of the software program . This reads on "purchase", because a rental of software is merely a time-limited purchase. That is, software purchases are licensing agreements allowing specific usage rights. A rental is merely a purchase agreement of usage rights with an expiration based on either number of uses, time of usage, or possibly a time limit on usage.

(iii) Applicant's other arguments are directed to the disclosure and not the claims.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

P 17 L

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APPENDIX TO EXAMINER'S ANSWER

The following is a true copy of claims 6, 7, 10, 14, and 20 which were not present in the Appendix supplied with Applicant's Appeal Brief.

6. Authorising software, stored in a device or physically on a medium, as claimed in claim 3, wherein further comprising a method, comprises the steps of :

- receiving a command from said remote computer;
- authenticating said command;
- determining the hardware or software or both configuration of said computer;
- storing the determined configuration if the authentication result of said authenticating step is favourable ;
- thereafter, determining at least a part of the configuration of a computer on which said software runs ;
- comparing said at least a part of configuration determined with the corresponding part in said stored configuration ;
- authorising use of said other software if the comparison result is favourable.

7. Authorising software, stored in a device or physically on a medium, as claimed in claim 6, wherein said command is being entered into said computer by the computer user who receives it from said remote computer through telephone line.

10. Authorising software, stored in a device or physically on a medium, as claimed in claim 9, said authorising software also comprises said information at said first predetermined location therein and an identity of its rightful user at said second predetermined location therein and an encrypted identity of its rightful user therein; and said authorising software will not authorise use of said other software on said computer if said information therein being altered or said identity therein and said encrypted identity therein being inconsistent.

14. Software, stored in a device or physically on a medium, as claimed in claim 13, wherein said authorising software also comprises said information at said first predetermined location therein and an identity of its rightful user at said second predetermined location therein and an encrypted identity of its rightful user therein ; and said authorising software will not authorise use of said other software if said information therein being altered or said identity therein and said encrypted identity therein being inconsistent.

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20. Authorising software, stored in a device or physically on a medium, as claimed in claim 19, said authorising software also comprises said information at said first predetermined location therein and an identity of its rightful user at said second predetermined location therein and an encrypted identity of its rightful user therein ; and said authorising software will not authorise use of said other software if said information therein being altered or said identity therein and said encrypted identity therein being inconsistent.